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10/006,685	12/10/2001	Masayuki Ike	16869K-034110US	1677

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TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

CHENCINSKI, SIEGFRIED E

ART UNIT	PAPER NUMBER
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3692

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/006,685

Applicant(s)

IKE ET AL.

Examiner

Siegfried E. Chencinski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 December 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 12/10/01.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION***Double Patenting***

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 of the instant application are provisionally rejected on the ground of nonstatutory double patenting over claims 1-7 of copending Application No:

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09/949,381. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

Claim 1 of the instant application reads as follows:

Re. Independent Claim 1, a method for managing, with a server computer, ordering and reserving of printed products/services using a paper medium directed to many and unspecified consumers, such as pamphlets/catalogues/leaflets printed with advertising information regarding such as products/services and attached with a unique code, the method including:

- a code-receiving procedure for receiving, from a reader terminal which performed reading of the unique code attached to said paper medium or an input terminal which received the input of the unique code, the unique code of the paper medium;
- a code-authentication procedure for authentication of the validity of the unique code, conducted by, regarding the unique code received from said reader terminal or input terminal, til authentication in a data base storing the unique code corresponding to said paper medium, or by requesting authentication to an issuing-and-certification authority which is the origin of said unique code and obtaining the result of the authentication request;
- an individual-specific-information-receiving procedure for receiving from said reader terminal or input terminal the requesting event, presented by a consumer through said reader terminal or said input terminal, of ordering and reserving by the consumer regarding the product/service printed on said paper medium, and individual-specific information which can specify the consumer;
- a paper medium ticketing procedure, for corresponding in said data base, the consumer specified by the individual-specific information with the unique code

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authenticated by said code authentication procedure, as well as recording receiving of an ordering-and-reserving demand by the consumer regarding the printed product/service of the paper medium attached with said unique code; and

- a result-sending procedure for sending a result of the ticketing in said paper medium ticketing procedure to said reader terminal or input terminal.

Claim 1 of application 09/949,381 reads as follows:

Re. Independent Claim 1, a method for managing, with a server computer, ordering and reserving of printed products/services using a paper medium directed to many and unspecified consumers, such as pamphlets/catalogues/leaflets printed with advertising information regarding such as products/services and attached with a unique code, the method including:

- an ID-receiving procedure for receiving, from a reader terminal which performed reading of the unique code attached to said paper medium or an input terminal which received the input of the unique code, the unique code of the paper medium;
- a chip-authentication procedure for authentication of the validity of the unique code, conducted by performing, regarding the unique code received from said reader terminal or input terminal, authentication in a data base storing the unique code corresponding to said paper medium, or by requesting authentication to an issuing-and-certification authority which is the origin of said unique code and obtaining the result of the authentication request;
- an individual-specific-information-receiving procedure for receiving from said reader terminal or input terminal the requesting event, presented by a consumer through said reader terminal or said input terminal, of ordering and reserving by the consumer regarding the product/service printed on said paper medium, and individual-specific information which can specify the consumer;
- a chip-ticketing ticketing procedure, in said data base and the RFID chip, the consumer specified by the individual-specific information with the unique code authenticated by said code authentication procedure, as well as recording

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- receiving of an ordering-and-reserving demand by the consumer regarding the printed product/service of the paper medium attached with said unique code; and
- a result-sending procedure for sending a result of the ticketing in said paper medium ticketing procedure to said reader terminal or input terminal.

In the instant application, a unique code read by a reader terminal from a paper medium performs the same function as a code being read by a reader terminal which reads the code from an RFID chip in copending application 09/949,381. All the method claims 1-6 and the systems claim 7 perform the same functions in the same way in the two applications. An ordinary practitioner of the art would have seen it as obvious that different code bearing media and devices could be used to accomplish the same code transfer function.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

Specification

2. OBJECTION

The abstract of the disclosure is objected to because it exceeds the maximum permitted length of 150 word, and because it contains references to the drawings which obscure the purpose of the Abstract. Correction is required. See MPEP § 608.01(b), which is duplicated here for Applicant's convenience:

(b) A brief abstract of the technical disclosure in the specification must commence on a separate sheet, preferably following the claims, under the heading "Abstract" or "Abstract of the Disclosure." The sheet or sheets presenting the abstract may not include other parts of the application or other material. The abstract in an application filed under 35 U.S.C. 111 may not exceed 150 words in length. The purpose of the abstract is to enable the United States Patent and Trademark Office and the public generally to determine quickly from a cursory inspection the nature and gist of the technical disclosure.<

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Applicant is reminded of the proper content of an abstract of the disclosure.

A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;
- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

Extensive mechanical and design details of apparatus should not be given.

Applicant is requested to rewrite the Abstract to comply with the spirit and letter of the above guidelines, and to correct the causes of the objection. The Abstract submitted is primarily a recitation of components and systems procedures. The public generally would find it difficult to discern from a cursory inspection the nature and gist of the invention. Applicant is advised to build the Abstract around the summary of needs in the last paragraph of the Background statement in the Specification, making sure that it is consistent with the gist of the summary of the invention section which follows that paragraph. Applicant also is requested to shorten the Abstract to 150 words or less, and to avoid reference marks to the specification and the drawings.

Claim Objections

3. **Claims 1 and 2 are objected to** because of the following informalities:

Re. Claim 1: Limitation element (b) of claim 1 appears to be missing a connecting word in the phrase "conducted by, regarding the unique". The word "performing" seems to belong here to result in the phrase "conducted by performing, regarding the unique"

Re. Claim 2: Limitation element (c) of claim 2 appears to be missing a connecting word in the phrase "for corresponding the consumer with". The contextual intent seems to call for the insertion of the word "with" to result in the phrase "for corresponding with the consumer".

Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. **Claim 6 is rejected** under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claim must be in an active form of a verb (verb + "ing"), e.g. "comparing", "determining".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 1-7 are rejected** under 35 U.S.C. 103(a) as being unpatentable over Janning et al. (US patent 6,446,049 B1, hereafter Janning) in view of Kirkham (US Pregrant Publication 2002/0067267 A1) and Miura et al. (US PreGrant Publication 2001/0025884 A1, hereafter Miura).

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Re. Claims 1 & 7, Janning discloses a method and system for managing, with a server computer, ordering and purchasing of products and services with an RFID chip with a corresponding unique ID therein, the method and system including:

- an ID-receiving procedure for receiving, from a reader terminal which performed reading of the unique code (Col. 2, ll. 37-40, 42-47);
- a chip-authentication procedure for authentication of the validity of the unique code, conducted by performing, regarding the unique code received from said reader terminal or input terminal, authentication in a data base storing the unique code, (col. 2, ll. 47-49);
- a individual-specific-information-receiving procedure for receiving from said reader terminal or input terminal the requesting event, presented by a consumer through said reader terminal or said input terminal, of ordering and reserving by the consumer regarding a product or service, and individual-specific information which can specify the consumer (implicit in col. 2, ll. 47-49);
- a chip-ticketing procedure, in said data base and the RFID chip, the consumer with the consumer specified by the individual-specific information with the unique code authenticated by said code authentication procedure, as well as recording receiving of an ordering-and-reserving demand by the consumer regarding the printed product/service of the paper medium attached with said unique code (col. 2, ll. 48-53); and
- a result-sending procedure for sending a result of the purchase to said reader terminal or input terminal (col. 2, ll. 48-53).

Janning does not explicitly disclose a paper medium which has printed on it the unique identifying code which is stored electronically within the chip, and the product or service being purchased by the user.

However, Janning discloses a method and system wherein the unique code containing device and the related printed material are dedicated to a specific service or vendor organization (printed materials – col. 2, ll. 41-42; single vendor focused system – col. 2, l. 62-col. 3, l. 1).

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Also, Kirkham discloses a package to be used for display purposes which has a code containing tag attached to it (Abstract, ll. 1-4). Also, it was well known at the time of Applicant's invention that a lot of packaging used in display situations was made of paper due to its low cost, excellent printability and easy disposability. Further, Miura discloses that electronic tags can be attached to sheets of paper (p. 1, [0001]-l. 3).

These disclosures demonstrate that, at the time of Applicant's invention, readable tags containing or carrying unique codes had been known to be used attached to sheets of paper and also attached to paper in promotional situations. The ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious that 1) Readable tags perform a simple code conveyance function, and 2) various means of carrying a code on a paper medium in or with an attachment to a paper medium would perform the same function if it can be read by a code-reading terminal. Such an arrangement thus would satisfactorily perform the same function of conveying such a code as an attachment to printed paper advertising and promotional brochures in the process of attracting prospective customers to purchase a particular product or service, thus making it easy to make an immediate purchase through the communications features of a readable unique code. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the disclosures of Janning, Kirkham and Miura to implement a method and system for ordering and paying for a product or service through a reader terminal readable unique code attached to a paper medium, motivated by a desire to satisfy demand for greater convenience and transaction speed for consumers and competitive advantages for retailers to enable rapid, cashless purchase transactions (Janning, Col. 1, ll. 51-60).

Re. Claim 2, Janning discloses a method and system which provides computer network automated settlement of purchases made remotely through a reader terminal, including the steps of information receiving, settlement processing including the price, recording the completed event and sending of the settlement results of the transaction to the reader terminal used by the consumer to initiate the purchase transaction (Col. 2, ll. 3-6, 44-55). Neither Janning nor Kirkham explicitly disclose the use of a PIN number related to a settlement account. However, Janning discloses a secondary account

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number to serve as a security code. Further, the examiner takes Official Notice that the use of PIN numbers in combination with such as financial account numbers and credit card numbers was so well known that it was ubiquitous at the time of Applicant's invention. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the disclosures of Janning and Kirkham with information well known in the art to implement a transaction settlement and confirmation procedure including the receiving of the settlement information such as credit card or other payment account information, a networked computer to process the settlement information, the recording of the purchase transaction settlement information, and the final confirmation communication step to the customer at the reader-writer terminal where the customer user has initiated the transaction. A motivation would have been a desire to satisfy demand for greater convenience and transaction speed for consumers and competitive advantages for retailers to enable rapid, cashless purchase transactions (Janning, Col. 1, ll. 51-60).

Re. Claim 3, Janning discloses a method and system wherein said settlement information is included in said individual-specific information, and said settlement-information-receiving procedure is included in said individual-specific-information-receiving procedure (Col. 2, ll. 15-55, see SPEEDPASS and RFID-chip operation).

Re. Claim 4, neither Janning nor Kirkham explicitly disclose a method wherein a ticket-settling procedure is included in the paper medium ticketing procedure. However, as explained in the rejections of claims 1-3 above, it would have been obvious to an ordinary practitioner at the time of Applicant's invention to see that the steps disclosed by Janning could be used for a ticket-settling procedure since Janning's steps could be universally applied to many types of transactions including, for example, those involving the purchase of printed materials, airline tickets, theater tickets, hotel rooms, rental cars, and gasoline (Col. 2, ll. 15-55, see SPEEDPASS and RFID-chip operation). Therefore, it would have been obvious to an ordinary practitioner of the art at the time of Applicant's invention to combine the disclosures of Janning and Kirkham to include a method wherein a ticket-settling procedure is included in the paper medium ticketing procedure, motivated by a desire to satisfy demand for greater convenience and transaction speed

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for consumers and competitive advantages for retailers to enable rapid, cashless purchase transactions (Janning, Col. 1, ll. 51-60).

Re. Claim 5, Janning discloses a method and system wherein appropriate printing letter and print data indicating that said paper medium ticketing procedure or said ticket-settling procedure is completed, is sent to said reader terminal or input terminal mounted on a printer or connected thereto or having a printer function, and instruction to print to said paper medium is performed (Col. 2, ll. 6-14. The capability of printing of transaction receipts as an automatic or optional item for the user is implicit in the use of fuel dispensers of the type disclosed in this section of Janning.).

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Janning in view of Walker et al. (US Patent 6,434,534 B1, hereafter Walker534) and Walker et al. (US Patent 6,128,599 A, hereafter Walker599).

Re. Claim 6, Janning discloses a method and system for managing, with a server computer, the advertising, promotion, ordering and purchasing of products and services with an RFID chip with a corresponding unique ID therein (see claim 1 above).

Janning does not explicitly disclose an advertising-effect-analysis method wherein a distribution information, including any of a distribution area, a distribution period, a distributed subject, a distributed number, and a content of the advertising information of said paper medium, is recorded in said data base while being related with a unique code mounted on the paper medium; wherein an attribute of a consumer, determined from said individual specific information regarding the consumer performing the ordering and reserving of the printed product/service through said paper medium, is compared with said distribution information corresponding to the a unique code used for ordering and reserving by the consumer; and wherein an advertising effect regarding said paper medium is analyzed.

However, Walker534 discloses a method for analyzing the effects of time period limited reward offers in electronic data collected from customer credit card transactions (Col. 3, ll. 19-52; col. 4, ll. 33-36). Walker determines consumer attributes through the financial attributes of the account holder and attributes which emerge from the periodic analysis

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of reward periods and programs depending on the nature of the rewards and the ways in which a client such as a credit card company wishes to stimulate their account holders. Further, Walker599 discloses the analyzing of stored card holder account activity tables for the usage activity of each account holder. The disclosed account activity data fields include transaction field, account ID field, merchant ID field, transaction ID field, date field, time field and credit card authorization number. A credit card company is like any other business which has a business interest in sales and marketing to use advertising and promotion stimulation measures seek additional customers and to increase its volume and profitability of its existing customer base. An ordinary practitioner of the art at the time of Applicant's invention would have seen it as obvious that these practices are applicable to any business, including printing businesses and other businesses. Therefore, it would have been obvious to an ordinary practitioner of the art at the time of the invention to have combined the disclosures of Janning, Walker534 and Walker599 in order to institute a method and system for managing, with a server computer, the advertising, promotion, ordering and purchasing of products and services with a unique code, motivated by a desire for promoting the use of products and services as exemplified by the promotion of financial accounts (Walker534 Col. 1, ll. 15-17).

Conclusion

7. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Siegfried Chencinski whose telephone number is (571)272-6792. The Examiner can normally be reached Monday through Friday, 9am to 6pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Richard E. Chilcot, can be reached on (571) 272-6777.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR

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only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks, Washington D.C. 20231


or (571)273-8300 [Official communications; including After Final communications labeled "Box AF"]

3-6792 [Informal/Draft communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the address found on the above USPTO web site in Alexandria, VA.

SEC

January 8, 2007


FRANTZY POINVIL
PRIMARY EXAMINER
AU 3692